

Application No. 09/663,872

REMARKS

Claims 1-27 are pending.

Claims 1, 4-12 and 15-27 stand rejected.

Claim Objections

Claim 24 was objected to under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 24 has been deleted.

Claim Rejections – 35 U.S.C. §112

Claims 1, 4-12 and 15-19 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention which rejection is traversed.

Claim 1 has been amended to recite “primary particles” instead of “primary articles”. Further, and with regard to claim 1, line 7, Applicants are of the view that claim1, line 7 is understandable to one skilled in the art and meets the requirements of 35 U.S.C. § 112, second paragraph.

“The first sentence of the second paragraph of § 112 is essentially a requirement for *precision and definiteness* of claim language. If the scope of subject matter embraced by a claim is clear, and if the applicant has not otherwise indicated that he intends that claim to be of a different scope, then the claim does particularly point out and distinctly claim the subject matter which the applicant regards as his invention.” *In re Borkowski*, 422 F.2d 904, 164 U.S.P.Q. 642 (C.C.P.A. 1970).

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Claim Rejections – 35 U.S.C. §102

Claims 21 and 26 were rejected under 35 U.S.C. §102(b) as being anticipated by EP 472 459 A1 which rejection is traversed.

Claims 21 and 26 have been amended to recite that the apparatus and method further comprise a coater adapted to coat the resulting filtered stream containing a dispersion of de-agglomerated primary particles onto a receiver. The Examiner has not pointed out in EP 472 429 A1 a coater for coating the resulting stream.

Claim Rejections – 35 U.S.C. §103

Claims 1, 4-7, 10, 12, 16-20 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kawaski et al. (US Patent 5,576,075), in view of Hochberg (US Patent 3,890,240) which rejection is traversed.

Claim 1 has been amended to include the coating of the resulting sonicated stream onto a **photoreceptor** substrate and the Examiner has not pointed out where in Kawaski et al. this combination can be found. The Examiner has failed to point out in either reference a dispersion comprised of agglomerated primary particles. The Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998)

With regard to claims 5 and 6, the Examiner has failed to show where the references to Kawaski et al., or Hochberg teaches agglomerated primary particles in the sonicated stream in an amount of from about 0 to about 60 weight percent based on the total weight of the stream. Further, the Examiner has not

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pointed out in *Kawaski et al.* nor *Hochberg*, where there is shown de-agglomerated primary particles of a volume average diameter of from about 0.005 to about 20 micrometers together with a resulting sonicated stream coated onto a photoreceptor substrate. The Examiner has not pointed to any suggestion, motivation or incentive for modifying either reference to arrive at the Applicants disclosure. See *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989) ("[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (quoting *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)).

The Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). See also *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.")

With regard to claims 10 and 12, the Examiner has not shown in either reference a continuous phase liquid solvent, a sonication that is accomplished with at least one ultrasonic member and wherein said ultrasonic member comprises from about 1 to about 10 ultrasonic horns, together in combination with a resulting sonicated stream coated onto a photoreceptor substrate.

Claim 14 was cancelled in paper 5, the amendment transmitted on January 15, 2003.

With regard to claims 16 through 19, the Examiner has not pointed out where in *Kawaski et al.* there can be found in combination, measuring the stream pressure just prior to filtering, re-agglomerating the primary particles, and analyzing

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the sonicated stream for third particles arising from the degradation of the primary particles during sonication.

With regard to claim 27, the Examiner has not shown in either reference the combination of a liquid dispersion of agglomerated primary particles, wherein a coater is adapted to coat a photoreceptor substrate.

The Federal Circuit has repeatedly warned that the requisite motivation must come from the prior art, not Applicant's specification. See *In re Dow Chem. Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988) ("there must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure"). Using an Applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of §103, which requires judging obviousness at the point in time when the invention was made. See *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

With regard to the above rejection, the Examiner is using an impermissible "obvious to try" analysis.

The Examiner has listed items (1) through (6) and states that it would have been "obvious to try" to modify and vary these parameters or try these 6 possible choices to arrive at the Applicant's invention where the prior art gave no indication of which parameters were critical and no suggestion is found within the references themselves for these 6 modifications.

[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (quoting *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)).

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Further, and with regard to the above rejection, the Examiner has used an impermissible "hindsight reconstruction". The Examiner has used the Applicant's disclosure as a guide through the prior art, combining the references in just the right order to arrive at the Applicant's claimed invention. This is an impermissible approach. See *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

Claims 8-9 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kawaski et al., in view of Hochberg as applied to claims 1, 4-7, 10, 12, 16-20 and 27 above, and further in view of EP 472 459 A1 which rejection is traversed.

With regard to claims 8 and 9 it seems that the Examiner is again using an impermissible hindsight analysis. The Examiner has not pointed out in either reference the filtering of at least one objectionable contaminant or wherein the contaminant has an average diameter particle size greater than the average diameter of the de-agglomerated particles, nor any suggestion or motivation for combining 3 references to arrive at the Applicants' disclosure. It seems that the Examiner has used the Applicant's disclosure as a guide in order to piece together references and reconstruct the Applicant's invention.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The Examiner has pieced together elements from 3 different references without pointing to any suggestion within the references for modifying the references in such a manner.

With regard to claim 15, the Examiner has not pointed to any suggestion for modifying Kawasaki et al. in view of Hochberg to additionally provide an ultrasonicator for the filter as disclosed in EP 472, 459 A1. The EP 472,459 A1 reference contains no suggestion, motivation, or incentive for an ultrasonicated filter

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used in the homogenising of a radioactive fuel residue in combination with a method for the production of magnetic recording media together with a composition and method for toner preparation. "The Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

Further and with regard to claims 8-9 and 15, EP 472,459 A1 is non-analogous art. A person of ordinary skill in the imaging toner art will not likely know about prior art in the radioactive fuel reclamation art. EP 472 459 A1 relates to treating a residue resulting from dissolving spent nuclear reactor fuel elements in hot nitric acid. Further, the problems associated with treating spent nuclear reactor fuel elements are not reasonably related or pertinent to problems in the imaging arts. For purposes of evaluating the obviousness of claimed subject matter, one must make certain that a particular reference relied upon constitutes "analogous art." *In re Clay*, 966 F.2d 656, 658-59, 23 U.S.P.Q.2d 1058, 1060-61 (Fed. Cir. 1992).

Claims 21-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kawaski et al. (US 5,576,075), in view of EP 472,459 A1 which rejection is traversed.

The Examiner has not pointed to any suggestion within the reference, EP 472, 459 A1 for combining the reference that relates to the homogenising and conveyance of a mixture of radioactive fuel residue with a reference for a composition and method for the production of magnetic recording medium to arrive at the Applicant's disclosure.

With regard to claim 21, the Examiner has not pointed to any suggestion within either reference for combining the ultrasonicator of Kawasaki et al. with the untrasonicated filter of EP 472, 459 A1. EP 472, 459 A1 relates to

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radioactive fuel residues and the Examiner has not stated in the Official Office Action any motivation or incentive for one of ordinary skill in the radioactive fuel reclamation art to modify an invention for the magnetic recording media or toner arts.

Claim 22 has been deleted.

With regard to claim 23 the Examiner has not pointed out in Kawasaki et al. where the coated receiver is substantially free of agglomerated primary particles. The Examiner has pointed to columns 1 and 36 to support the Examiner's position, however, these columns only indicated that the agglomeration is rendered "difficult", or "and only sparingly suffer agglomeration". These terms do not amount to "substantially free" of agglomerated particles.

Claim 24 has been deleted.

With regard to claims 25 and 26, the Examiner has not pointed to any suggestion, motivation, or incentive within the references themselves for modifying either reference to arrive at a method for sonicating a stream comprised of agglomerated primary particles or that provides a second ultrasonicator that ultrasonicates the filter member when the coater is inactive.

Further and with regard to claims 21-26, EP 472,459 A1 is non-analogous art. A person of ordinary skill in the imaging toner art will not likely know about prior art in the radioactive fuel reclamation art. EP 472 459 A1 relates to treating a residue resulting from dissolving spent nuclear reactor fuel elements in hot nitric acid. Further, the problems associated with treating spent nuclear reactor fuel elements are not reasonably related or pertinent to problems in the imaging arts. For purposes of evaluating the obviousness of claimed subject matter, one must make certain that a particular reference relied upon constitutes "analogous art." *In re Clay*, 966 F.2d 656, 658-59, 23 U.S.P.Q.2d 1058, 1060-61 (Fed. Cir. 1992).

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Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kawaski et al., in view of Hochberg as applied to claims 1, 4-7, 10, 12, 16-20 and 27 above, and further in view of Min et al. (US 4112549) which rejection is traversed.

With regard to claim 11, the Examiner has failed to point out in the reference to Min et al. any suggestion, motivation, or incentive for combining an apparatus for the deflocculation of a dry suspension of fibers with a method for the production magnetic recording media, together with a composition and method of preparing toner. The Examiner correctly indicates what each of the references teaches, however, the Examiner has not pointed out in any of the references where there can be found any suggestion for combining these references in the manner asserted by the Examiner. Additionally, the Examiner has failed to explicitly say in the Official Office Action, what the prior art references implied that would suggest or motivate one of ordinary skill to combine the references.

Further and with regard to claim 11, Min et al. is non-analogous art. A person of ordinary skill in the imaging toner art will not likely know about prior art in the paper making art. Min et al. relates to treating a residue resulting from dissolving spent nuclear reactor fuel elements in hot nitric acid. Further, the problems associated with treating spent nuclear reactor fuel elements are not reasonably related or pertinent to problems in the imaging arts. For purposes of evaluating the obviousness of claimed subject matter, one must make certain that a particular reference relied upon constitutes "analogous art." *In re Clay*, 966 F.2d 656, 658-59, 23 U.S.P.Q.2d 1058, 1060-61 (Fed. Cir. 1992).

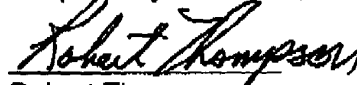
Accordingly, the Examiner has not established a prima facie case of obviousness with respect to the 35 U.S.C. § 103 rejections.

The application and claims are believed to be in a condition for allowance in their present form and which allowance is respectfully requested.

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In the event the Examiner considers personal contact advantageous to the disposition of this case, the Examiner is hereby authorized to call Applicant's Attorney, Robert Thompson, at Telephone Number (585) 423-2050, Rochester, New York.

Respectfully submitted,

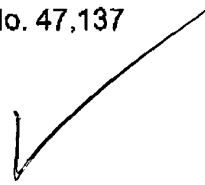


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VERSION WITH MARKINGS TO SHOW CHANGES MADE:

IN THE CLAIMS:

1. (Twice Amended) A method comprising:

sonicating a stream containing a dispersion comprised of agglomerated primary particles; filtering the resulting sonicated stream containing a dispersion comprised of de-agglomerated primary particles and further comprising coating the resulting sonicated stream onto a receiver surface wherein the receiver surface is a coated photoreceptor substrate and wherein the de-agglomerated primary particles are separated in the resulting sonicated stream.

21. (Twice Amended) An apparatus comprising:

an ultrasonicator adapted to ultrasonicate a stream of a liquid dispersion of agglomerated primary particles; a filter member adapted to filter the resulting ultrasonicated stream containing a dispersion of de-agglomerated primary particles; and

further comprising a second ultrasonicator adapted to ultrasonicate the filter member and a coater adapted to coat the resulting filtered stream containing a dispersion of de-agglomerated primary particles onto a receiver.

Claims 22 and 24 were cancelled.

25. (Amended) The apparatus in accordance with claim [24]21, wherein the second ultrasonicator ultrasonicates the filter member when the coater is inactive.

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26. (Amended) A method comprising:

sonicating a stream containing a dispersion comprised of agglomerated primary particles; [and]filtering the resulting sonicated stream containing a dispersion comprised of de-agglomerated primary particles, further comprising sonicating the filter media with a second sonicator during the filtering of the sonicated stream; and coating the resulting filtered stream containing a dispersion of de-agglomerated primary particles onto a receiver.